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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,704	08/30/2005	Gerd Dahms	BPD-0014	9138
23413 7590 04/10/2009 CANTOR COLBURN, LLP 20 Church Street 22nd Floor Hartford, CT 06103				
EXAMINER				
HOLT, ANDRIAE M				
ART UNIT		PAPER NUMBER		
1616				
NOTIFICATION DATE		DELIVERY MODE		
04/10/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptopatentmail@cantorcolburn.com

### Office Action Summary

**Application No.**

10/517,704

**Applicant(s)**

DAHMS, GERD

**Examiner**

Andriae M. Holt

**Art Unit**

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-21 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This office action is in response to applicant's arguments filed December 23, 2008. Claims 17-21 and 23 are pending in the application. Claims 17-21 and 23 will presently be examined to the extent they read on the elected subject matter of record.

Rejections not reiterated from the previous Office Action are hereby withdrawn. The following rejections are newly applied. They constitute the complete set of rejections and/or objections presently being applied to the instant application.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17-20 and 23 rejected under 35 U.S.C. 102(b) as being anticipated by Zuckert et al. (US 3,979,346).

Zuckert et al. disclose emulsion systems for preparing aqueous dispersions of alkyd resins; aqueous dispersions of alkyd resins, and a process of making the dispersions (Abstract). Zuckert et al. disclose the emulsifier system is a combination of a) at least one non-ionic emulsifier, the hydrophobic part of which consists of two or more radicals of unsaturated fatty acids and/or fatty alcohols with an iodine number between 130 and 200 (oil), and the hydrophilic part consists of chains of polyethylene glycol and/or monomethoxypolyethylene glycol with 6 - 100 ethylene oxide units (ether

alcohol of formula I, n is 7 to 15, ether alcohol/polyol phase); and b) at least one anionic emulsifier, the hydrophobic part of which consists of two or more radicals of unsaturated fatty acids and/or fatty alcohols with an iodine number of between 130 and 200, and the hydrophilic part consists of carboxy groups, at least 50 percent of which are dissociated by the ammonia utilized. Zuckert et al. disclose that minor amounts of organic solvents can be employed (aqueous phase) (col. 2, lines 53-68-col. 3, lines 1-7) .

Zuckert et al. disclose in example E. 01 (nonionic emulsifier) that 880 g of linseed oil (oil) are reacted with a total of 200 g of maleic anhydride to form an adduct. The linseed-maleic anhydride-adduct (8.8 : 2) obtained is mixed with 36 g of water and a catalytic quantity of triethylamine and held at reflux for 3 hours. The components are mixed 1 : 3 (opened adduct : ethylene oxide). The resulting product is highly viscous yellow oil with an ethylene oxide content of 75 percent by weight. Zuckert et al. further disclose in example E. 02 a mixed nonionic-anionic emulsifier. 1080 g linseed-maleic anhydride-adduct (8.8 : 2) (oil, emulsifier) of E. 01 are reacted at with 2200 g of methoxypolyethylene glycol (molecular weight about 1100) (ether alcohol/polyol phase) until the acid value has fallen to 30 - 35 mg KOH/g. The resultant yellow wax-like mass has an ethylene oxide content of 67 percent by weight (col. 6, lines 1-22). Zuckert et al. disclose more examples of the preparation of nonionic emulsifiers in examples E.06 and E.07 (col. 7, lines 7-20). Zuckert et al. disclose in Table II, cols. 9-10 lines 11-65, dispersion blends, particularly, A2 E.06/6% (oil and ether alcohol/polyol phase), E.09/1% (anionic emulsifier) and 1.25%NH<sub>3</sub> (aqueous phase).

Zuckert et al. meet all of the limitations of the claims and thereby anticipates the claims.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mather et al. (WO 96/39119).

***Applicant's Invention***

Applicant claims an ether alcohol/polyol-in-oil emulsion comprising at least one ether alcohol of the general formula (I)  $R_1-O-[EO]_n H$  where  $R_1$  is C1-3-alkyl,  $n$  is on average 7 to 15, and EO is building blocks derived from ethylene oxide, in an oil-immiscible ether alcohol/polyol phase, an oil phase and at least one emulsifier. Applicant further claims that a cosmetic and/or pharmaceutical and/or agrochemical active ingredient is dissolved in the ether alcohol/polyol phase.

***Determination of the scope of the content of the prior art  
(MPEP 2141.01)***

Mather et al. teach the invention relates to topical compositions containing azelaic acid and glycol and more particularly to new and improved compositions containing stabilized and completely solubilized azelaic acid (page 1, lines 7-10). Mather et al. further teach that another objective is to provide lower, yet effective concentrations

of a topical azelaic acid formulation that is less likely to irritate the skin of the user (page 5, lines 5-7). Mather et al. teach that azelaic acid, a straight chain dicarboxylic acid with 9 carbons, has limited solubility in water and commonly used cosmetic oils. Mather et al. teach that low levels of azelaic acid may be completely dissolved in glycol from about 20% (w/w) to about 60% (w/w) (claim 20, 50 % weight, instant invention) and remain in stable solution (page 4, lines 20-25). Mather et al. teach that the glycol utilized may be one or more of the following, including methoxypolyethylene glycol (page 4, lines 25-28) (ether alcohol, methanol ethoxylate, claims 17 and 20, instant invention). Mather et al. teach that if lower levels of azelaic acid are used, the glycol level can be reduced and conventional emulsions with cosmetic oils formed (page 6, lines 19-24).

Mather et al. teach on page 8, in example 3, lines 15-34, that an emulsion with commonly used cosmetic oils is made by mixing azelaic acid with dipropylene glycol and distilled water, which the mixture is then heated to 70° C until a clear solution results (claim 21, comprises a pharmaceutical active, instant invention). Mather further teaches that in a separate container C12-C15 benzoate, isododecane, cyclomethicone, stearyl alcohol (claim 17, emulsifier, instant invention), a commercial mixture of glyceryl stearate and PEG-100 stearate (ARLACEL 165) and a commercial mixture of isopropylparaben, isobutylparaben and butylparaben (LIQUAPAR OIL)(claim 17, oil, instant invention). Mather et al. teach that to this mixture the azelaic acid-dipropylene glycol-water mixture is added and the whole mixed while maintaining the temperature at 70° C. Mather et al. further teach the mixture is allowed to cool to 45° C.

***Difference between the prior art and the claims  
(MPEP 2141.02)***

Mather et al. do not teach the use of the specific ether alcohol of general formula (I), wherein the number of ethylene oxide units is 7.

***Finding of obviousness/Rationale and Motivation  
(MPEP 2142-2143)***

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Mather et al. and use specific ether alcohol of general formula wherein the number of ethylene oxide units is 7 in the compositions as taught by Mather et al. Mather et al. teach the use of glycol derivatives to prepare emulsions containing a pharmaceutical agent, particularly methoxypolyethylene glycol, which is in the general class of ether alcohols represented by compounds of formula I. One skilled in the art at the time the invention was made would have been motivated to use methoxypolyethylene glycol with a reasonable expectation of success since Mather et al. teach methoxypolyethylene glycol and dipropylene glycol can be used as the glycol in azelaic acid compositions. Therefore, it would have been prima facie obvious to substitute one glycol such as methoxypolyethylene glycol for another glycol such as dipropylene glycol since the prior art establishes methoxypolyethylene glycol and dipropylene glycol are all functional equivalents.

In reference to the number of ethylene oxide units in the ether alcohol being 7, it would have been obvious to the skilled artisan to use a methoxypolyethylene glycol with 7 ethylene oxide units as a matter of routine experimentation and optimization. As Mather et al. does not specify the number of ethylene oxide units that can be used in the composition, the skilled artisan would deem the use of methoxypolyethylene glycol

with 7 ethylene oxide units a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

Therefore, the claimed invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made because every element of the invention has been fairly suggested by the cited references.

Claims 17-20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zuckert et al. (US 3,979,346).

***Applicant's Invention***

Applicant claims an ether alcohol/polyol-in-oil emulsion comprising at least one ether alcohol of the general formula (I)  $R_1-O-[EO]_n H$  where  $R_1$  is C1-3-alkyl,  $n$  is on average 7 to 15, and EO is building blocks derived from ethylene oxide, in an oil-immiscible ether alcohol/polyol phase, an oil phase and at least one emulsifier. Applicant further claims the addition of at least one aqueous phase.

***Determination of the scope of the content of the prior art  
(MPEP 2141.01)***

The teachings of Zuckert et al. are incorporated herein by reference and are therefore applied in the instant rejection as discussed above.

***Difference between the prior art and the claims  
(MPEP 2141.02)***

Zuckert et al. do not teach specific examples where the number of ethylene oxide units is 7.

***Finding of obviousness/Rationale and Motivation***

***(MPEP 2142-2143)***

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Zuckert et al. and use specific ether alcohol of general formula wherein the number of ethylene oxide units is 7 in the emulsion systems taught by Zuckert et al. One skilled in the art at the time the invention was made would have been motivated to use methoxypolyethylene glycol that has 7 ethylene oxide units because Zuckert et al. specifically teach that the monomethoxypolyethylene glycol used in the system has 6-100 ethylene units. In addition the skilled artisan would have used the monomethoxypolyethylene glycol that has 7 ethylene oxide units as a matter of routine experimentation and optimization. As Zuckert et al. does not specify the number of ethylene oxide units that can be used in the composition, the skilled artisan would deem the use of methoxypolyethylene glycol with 7 ethylene oxide units a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

Therefore, the claimed invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made because every element of the invention has been fairly suggested by the cited references.

None of the claims are allowed.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andriae M. Holt whose telephone number is (571)272-9328. The examiner can normally be reached on 7:00 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richter Johann can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Andriae M. Holt  
Patent Examiner  
Art Unit 1616

/John Pak/  
Primary Examiner, Art Unit 1616